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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,230	06/12/2001	Kenneth C. Budka	2925-0551P	2080
30594 7590 05/15/2007 HARNESSE, DICKEY & PIERCE, P.L.C. P.O. BOX 8910 RESTON, VA 20195			EXAMINER PICH, PONNOREAY	
			ART UNIT 2135	PAPER NUMBER
			MAIL DATE 05/15/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/878,230	Applicant(s) BUDKA ET AL.	
	Examiner Ponnoreay Pich	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7,8,10,12-15,17,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-8,10, 12-15, 17 and 19-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/20/2007 has been entered. Any well known statements made in the prior office action not specifically or adequately traversed are taken as admittance of prior art as per MPEP 2144.03.

Claims 1-5, 7-8, 10, 12-15, 17 and 19-20 are pending.

Claim Objections

Claims 1, 19, and 20 are objected to because of the following informalities:

1. Claims 1, 19, and 20 refer to "the network", which should instead be "the wireless data and voice network" so as to be consistent with what is recited in the preamble of each claim.
2. "exists" in line 7 of claim 19 should be deleted.
3. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-8, 10, 12-15, 17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobi et al (US 6,584,095) in view of Inoue et al (US 6,891,819) as evidenced by Powell (US 5,991,617).

Claim 1:

Jacobi discloses receiving a communication address request for a temporary communication address from a mobile station, i.e. cell phone, by the wireless data and voice network, the communication address request including a mobile station's equipment identifier (EID) (col 2, lines 46-67). Note that the cited passage discloses a registration request for a cell phone, wherein the request uses the cell phone's device identifier, i.e. EID, to authenticate the cell phone and the registration request is a request for an IP address for the cell phone.

Jacobi does not explicitly disclose processing the communication address request based on a failure count accessed using the mobile station's EID, the failure count indicating a number of times the mobile station has been denied registration.

However, Inoue discloses processing registration requests for mobile computers based on a failure count, the failure count indicating the number of times registration requests has failed (col 13, lines 10-16). The cited passage also discloses that the failure counts corresponds to the mobile computer itself. This implies that the failure count is based on a failure count accessed using an identifier which corresponds to the mobile computer, i.e. the mobile computer's EID, which indicates the number of times

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registration has been denied for a particular mobile computer using a particular identifier.

Note that the difference between Jacobi and Inoue's teachings is that Jacobi teachings are directed explicitly towards cell phone registrations, where the registration is for an address and the registration uses the cell phone's EID. Inoue is directed towards mobile computer registration and keeping track of failure counts of the registration, the failure count corresponding to the mobile computer. A cell phone is a type of mobile computer. However, based on the teachings of both Jacobi and Inoue, it would have been obvious to one of ordinary skill in the art to combine the two teachings according to the limitations recited in claim 1. One skilled would have done so by incorporating the registration failure teachings of Inoue within Jacobi's invention so as to keep track of the number of times an address registration request of the cell phone fails based on the cell phone's device identifier, i.e. EID. One skilled would have been motivated to do so because it would prevent fraudulent usage of a cell phone by allowing detection of possibly stolen or cloned cell phones. As evidenced by Powell, cell phone fraud costs the cell phone industry several hundred million dollars a year (col 1, lines 10-13), thus one skilled would be interested in preventing cell phone fraud.

Claim 19:

Jacobi discloses receiving a communication address request for a temporary communication address from a mobile station by the wireless data and voice network, the communication address request including a mobile station's equipment identifier (EID) (col 2, lines 46-67).

Jacobi does not explicitly disclose determining a failure count corresponding to the mobile station's EID, which indicates a number of times the mobile station has been denied registration; and processing the communication address request when the failure count corresponding to the mobile station's EID satisfies one of the following conditions, (1) not existing and (2) existing but not exceeding a threshold.

However, as discussed in claim 1, Inoue discloses processing registration requests for mobile computers based on a failure count, the failure count indicating the number of times registration requests has failed (col 13, lines 10-16). The cited passage also discloses that the failure counts corresponds to the mobile computer itself. This implies that the failure count is based on a failure count accessed using an identifier which corresponds to the mobile computer, i.e. the mobile computer's EID, which indicates the number of times registration has been denied for a particular mobile computer using a particular identifier. Further, Inoue discloses processing a request by the mobile computer when the failure count corresponding to the registration id satisfies one of the following conditions, (1) not existing and (2) existing but not exceeding a threshold (col 10, lines 15-21; col 13, lines 10-29; col 16, lines 6-20).

In light of these teachings by both Jacobi and Inoue, it would have been obvious to one skilled in the art to combine the two teachings according to the limitations recited in claim 19 by processing the registration request of Jacobi, which uses the mobile station/cell phone EID in the registration, such that a failure count based upon the registration id/EID is tracked upon the EID not existing or existing but not exceeding a

threshold. One skilled would have been motivated to combine these two teachings for the same reasons discussed in claim 1.

Claim 20:

Claim 20 recite limitations substantially similar to what is recited in claim 19 and is rejected for similar reasons.

Claim 2:

The limitations recited in claim 2 are obvious over what is disclosed by both Jacobi and Inoue. Inoue discloses accessing the failure count for the mobile station's registration identifier (col 13, lines 10-29 and col 16, lines 6-20). The registration identifier as taught by Jacobi is the mobile station's EID (col 2, lines 46-67). Thus the limitation of accessing the failure count for the mobile station's EID would have been obvious to one of ordinary skill in the art.

Further, Inoue discloses ignoring the registration request when the failure count exceeds a predetermined threshold (Fig 14 and col 13, lines 23-33). Recall the type of registration Jacobi was concerned with was a communication address request. Thus, the teachings of Jacobi and Inoue would have made obvious the limitation of ignoring the communication address request when the failure count exceeds a predetermined threshold.

Claim 3:

Inoue further discloses continuing with a registration process when the failure count does not exceed a predetermined threshold (Fig 14 and col 13, lines 23-33).

Claims 4 and 12:

Inoue discloses incrementing the failure count for the mobile station when during the registration process, the registration id is not authenticated (Fig 14). Further, recall that with Jacobi's invention, failure to authenticate the registration id means failure to authenticate the mobile station since the mobile station's device identifier is used in the registration process (col 2, lines 46-67). Thus, the teachings of Jacobi and Inoue makes obvious the limitation of incrementing the failure count for the mobile station when during the registration process the mobile station is not authenticated.

Claims 5 and 13:

Inoue further discloses sending a message to the mobile station instructing the mobile station not to attempt registration for a predetermined period of time when the incremented failure count equals or exceeds the predetermined threshold (col 12, lines 58-67).

Claims 7 and 14:

Jacobi and Inoue do not explicitly disclose decrementing the failure count after a predetermined period of time has elapsed from the sending step. However, as discussed in a previous office action, this limitation was well known in the art at the time applicant's invention was made. It would have been obvious to one of ordinary skill in the art to further modify Jacobi and Inoue's combination invention according to the limitations recited in claims 7 and 14. One skilled would have been motivated to do so because it would allow a legitimate user and mobile station to be able to attempt registration again without the need for manual intervention by an administrator.

Claims 8 and 15:

Claims 8 and 15 recite limitations substantially similar to what is recited in claims 7 and 14 and are rejected for the same reasons.

Claims 10 and 17:

Inoue further discloses incrementing the failure count for the mobile station when a failure count was accessed and when during the registration process the registration failed (Fig 14 and col 13, lines 17-22), i.e. as per Jacobi's teachings, when the mobile station is not authenticated. Inoue further discloses initializing a failure count for the mobile station to an initial value when a failure count does not exist for the mobile station and when during the registration process authentication has not occurred (Fig 14 and col 13, lines 10-16), i.e. when the mobile station is not authenticated as per Jacobi's teachings. Thus, Jacobi and Inoue makes obvious to one of ordinary skill in the art the limitations recited in claims 10 and 17.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PP

Ponnoreay Pich
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Art Unit 2135



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